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Re: Application of: Christopher M. Benson
Serial No.: 10/015,431
Filed: December 13, 2001
For: System and Method for Short-Range Wireless
Retail Advertising Aimed at Short-Range Wireless
Protocol-Enabled Personal Devices
Group Art Unit: 2683
Examiner: Danh Cong Le
Our Docket No.: 9903 (1001-0779)

TRANSMITTAL OF APPEAL BRIEF

Please find for filing in connection with the above patent application the following documents:

1. Appeal Brief (19 pages);
2. A Check in the amount of \$500.00; and
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Respectfully Submitted,

MAGINOT, MOORE & BECK



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November 28, 2005

Enclosures



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

NCR Docket No. 9903

MMB Docket No. 1001-0779

Application of: **Benson**

Group Art Unit: **2683**

Serial No. **10/015,431**

Examiner: **Danh Cong Le**

Filed: **December 13, 2001**

For: **SYSTEM AND METHOD FOR SHORT-RANGE WIRELESS
RETAIL ADVERTISING AIMED AT SHORT-RANGE
WIRELESS PROTOCOL-ENABLED PERSONAL DEVICES**

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November 28, 2005

Date of Signature

APPEAL BRIEF

Sir:

This is an appeal under 37 CFR § 1.191 to the Board of Patent Appeals and Interferences of the United States Patent and Trademark Office from the final rejection of the claims 1-22 of the above-identified patent application. These claims were indicated as finally rejected in a final Office Action dated June 24, 2005. The \$500.00 fee required under 37 CFR § 41.20(b)(2) is filed herewith. Also, please provide any extensions of

time that may be necessary and charge any fees that may be due to Account No. 13-0014, but not to include any payment of issue fees.

(1) REAL PARTY IN INTEREST

NCR Corporation of Dayton, Ohio is the assignee of this patent application, and the real party in interest.

(2) RELATED APPEALS AND INTERFERENCES

There are no appeals or interferences related to this patent application (serial no. 10/015,431).

(3) STATUS OF CLAIMS

Claims 1-22 are pending in the application.

Claims 1-22 are finally rejected.

Claims 1-22 are being appealed, and are shown in the Appendix attached to this Appeal Brief.

(4) STATUS OF AMENDMENTS

Appellant has filed no amendments after receipt of the June 24, 2005, Final Office Action (the "Office Action").

(5) SUMMARY OF CLAIMED SUBJECT MATTER

The present invention relates to a short-range wireless advertising system and method. (Appellant's specification at page 1, lines 7-9). In one embodiment, a broadcasting system 10 includes a transmitter 30 that is in communication with an antenna 32. (Appellant's specification at page 9, lines 4-5 and FIG. 2). The transmitter 30 and antenna 32 are configured to generate a signal at about 2.4 GHz with a range of about 30 feet. (Appellant's specification at page 8, lines 18-22). A storage device 34 which stores one or more advertisements is in communication with the transmitter. (Appellant's specification at page 9, lines 13-16 and FIG. 2).

In accordance with one method, a store assembles an advertisement. (Appellant's specification at page 19, line 14 and FIG. 7). The advertisement is then loaded into the transmitting system and formatted into the desired protocol. (Appellant's specification at page 19, lines 14-16 and FIG. 7). The formatted advertisement is then transmitted to an enabled device such as a cellular phone or a personal digital assistant (PDA). (Appellant's specification at page 19, line 20 through page 20, line 1, FIG. 7 and page 7, lines 8-14). Thereafter, a response from the enabled device may be received. (Appellant's specification at page 20, lines 2-3 and FIG. 7).

Accordingly, the present invention provides a system and method that may be used, for example, to provide advertisements to potential customers that are proximate to a store in order to entice the potential customer to enter the store.

(6) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1, 2 and 5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Publication no. 2001/0014870 A1 of Saito et al. (hereinafter “Saito”) in view of U.S. Patent No. 5,150,127 to Aw (hereinafter “Aw”);¹

Claims 3, 4, 7-11, 13-17 and 19-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Saito and Aw in further view of U.S. Publication no. 2002/0008626 A1 to Waters et al. (hereinafter “Waters”);

Claims 6, 12 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Saito and Aw in further view of U.S. Patent no. 6,587,835 B1 to Treyz et al. (hereinafter “Treyz”); and

Claims 21 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Saito, Aw and Waters in further view of U.S. Patent no. 5,327,230 to Dockery (hereinafter “Dockery”).²

(7) ARGUMENT

Claims 1, 2 and 5 Are Not Obvious

¹ The Office Action alternatively refers to Saito as “Sato” or “Saito”. The spelling used in the published application, “Saito”, is used herein.

² The Office Action identifies U.S. Patent no. 5,327,230 as being issued to “McGlade.” U.S. Patent no. 5,327,230 is not issued to McGlade. A patent no. 5,227,230 is issued to a McGlade. The Applicant believes, based upon a review of the two patents, that the Examiner intended to rely upon the Dockery patent and merely used the wrong inventor name in referring to the Dockery patent. Accordingly, the Applicant will refer herein to U.S. Patent no. 5,327,230 to Dockery as “Dockery.” Additionally, it appears that the title for paragraph 4 of the Office Action should have referenced claims 21 and 22, not 3, 4, 7-11, 13-17 and 19-20.

Claims 1, 2 and 5 stand rejected under 35 U.S.C. §103(a) as being obvious over Saito in view of Aw. (Office Action at page 2). The invention of claims 1, 2 and 5 is not obvious when the invention is considered as a whole.

Discussion regarding Claim 1

1. Claim 1

Claim 1 states:

A method of providing an advertisement for a store to a prospective customer comprising the steps of:
 compiling an advertisement;
 formatting the advertisement into a radio signal having a radio transmission protocol that is receivable by a personal device of a prospective customer, the personal device having a radio receiver enabled to receive the transmission protocol signal; and
 transmitting the radio signal from the store with a signal strength sufficient to be received by a personal device that is removed from the source of the transmission.

Claim 1 thus recites a method wherein an advertisement is transmitted to the personal device of customer who is not in proximity to the transmitter.

2. The Elements are Not New

The Examiner relied primarily upon Saito in rejecting claim 1. The Examiner admitted, however, that the system of Saito was not intended to transmit to a receiver that was located remote from the transmitter. (Office Action at page 3). The Examiner then cited to Aw for teaching a transmitter having sufficient power to reach a receiver at a remote location. (Office Action at page 3).

Whether or not a transmitter of sufficient power to reach a receiver at a remote location was known at the time of the Applicant's invention is not an issue. The Applicant concedes that all of the technology required to implement the method/system

of the invention was available at the time of the invention. As noted by the predecessor court to the Federal Circuit, however, “[a] patentable invention, within the ambit of 35 *USC* 103, may result even if the inventor has, in effect, merely combined features, old in the art, for their known purpose, without producing anything beyond the results inherent in their use.” *In re Sponnoble*, 56 C.C.P.A. 823, 832; 405 F.2d 578, 585; 160 U.S.P.Q. 237, 243 (CCPA, 1969). Thus the salient issue is whether or not the Examiner has identified any teaching in the prior art which would suggest the necessity of selecting a more powerful transmitter than the transmitter of Saito. See, e.g., *id.* at 56 C.C.P.A. at 834, 405 F.2d at 586, 160 U.S.P.Q. at 244.

3. There Is No Motivation to Modify Saito

The Examiner has suggested that the motivation to provide a more powerful transmitter with the system of Saito is “to avoid the loss of signal strength.” (Office Action at page 3). This motivation for modifying the system of Saito is not identified in the prior art.

a. Saito Provides Motivation for Weaker Transmitters

Specifically, the avoidance of a loss of signal strength is not a problem addressed by Saito. Rather, Saito teaches that the problem that must be addressed in the system disclosed is that the disclosed transmitters provide *too much signal strength*. Saito notes that “in an environment where a plurality of the radio base stations 1101 are arranged, the radio signals generated by one radio base station 1101 can cause interferences with the radio signals generated by another radio base station 1101. For these reasons, the radio shield 1112 is provided in order to minimize the external radio disturbance factors

originating from the microwave oven or the other radio base station.” (Saito at paragraph 243). Thus, Saito has acknowledged that even the use of weak transmitters in the disclosed system can produce unacceptable levels of interference for other transmitters in the system.

Accordingly, Saito does not provide a basis for the motivation proposed by the Examiner. In fact, a fair reading of Saito teaches that the use of even weaker transmitters is desired. Saito suggests that a reduction in interference between a transmitter and receiver in close proximity may be achieved by increasing the shielding around the transmitter and the receiver. (See, e.g. Saito at paragraph 68 suggesting the use of additional shielding). Obviously, if a less powerful transmitter than the one disclosed by Saito is used, thereby decreasing the range of the transmitter, then less shielding is required. Thus, Saito provides motivation to substitute *weaker* transmitters in the disclosed system. A motivation to provide a *weaker* transmitter cannot reasonable be construed to be a motivation to provide a *stronger* transmitter. Therefore, there is no motivation for the proposed modification in Saito.

b. Aw Fails to Provide Motivation for the Proposed Modification

Aw is similarly void of any teaching or suggestion to modify the system of Saito to incorporate a more powerful transmitter. Aw discloses a portable radar simulator. (Abstract). Radars are used to illuminate aircraft for various reasons, some friendly and others more malevolent. In either event, it is generally desired to detect the illumination so that appropriate actions may be taken. (Aw at column 1, lines 34-43). The device of Aw is used to mimic various radar signals which may illuminate an aircraft to verify that

the radar detecting apparatus onboard the aircraft is sensitive enough to allow for the appropriate action to be taken, such as evasive maneuvers or implementation of electronic countermeasures. (Aw at column 1, lines 46-49 and column 2, lines 15-20). In accordance with the teaching of Aw, a radar simulator is provided that has a transmitter powerful enough to generate a simulated radar signal that should be detected and properly identified by a radar detector that is located sixty feet away from the portable radar simulator. (Aw at column 4, lines 39-44).

Thus, Aw discloses that a system may be designed that allows for the reception of a signal by a receiver located up to sixty feet away from the transmitter. Aw fails to disclose, however, any teaching or suggestion that the system described therein, including the design range selected, should be applied to a system that already exhibits too much interference from other transmitters in the system using less powerful transmitters.

c. The Examiner Has Failed to Identify A Motivation for the Modification

An increased signal strength may be an inherent feature of using a more powerful transmitter. An inherent property, however, is not a motivation. Accordingly, the Applicant willingly admits that if asked, one of ordinary skill in the art *could* design a system capable of transmitting a signal over sixty feet to a receiver with sufficient power to allow the signal to be processed at an acceptable bit error rate. What the Examiner has failed to identify, however, is any reason *why* one of ordinary skill in the art would determine that a transmitter of increased power *would be desired* in the system of Saito. Thus, the Examiner has failed to identify any motivation for the proposed modification of Saito.

4. Conclusion

Therefore, the Applicant acknowledges that if so motivated, one of ordinary skill in the art could design a communications system operable to provide communications between a transmitter and a remote receiver. The Applicant further acknowledges that the system of Saito provides a system for transmitting a coupon without the need for a communication provider. “The issue, then, is whether the teachings of the prior art would, in and of themselves and without the benefits of appellant’ disclosure, make the invention as a whole obvious.” *In re Spinnoble*, 56 C.C.P.A. at 833; 405 F.2d at 585; 160 U.S.P.Q. at 243.

The Applicant is not aware of any motivation in the prior art or in the reasoning presented in the Office Action for the design considerations of Aw to be incorporated into the system of Saito, particularly since Saito encourages the use of shielding because the transmitters used in the system of Saito are already too strong. Thus, the art cited by the Examiner fails to identify a teaching suggestion or motivation for the proposed modification and the Examiner has failed to identify any teaching of the desirability for such a combination outside of the Applicant’s specification. Accordingly, the Board of Appeals is respectfully requested to reverse this rejection of claim 1.

Discussion regarding Claims 2 and 5

The Examiner rejected claims 2 and 5 on the same grounds as claim 1. (Office Action at page 3). Claims 2 and 5 depend from claim 1 and include all of the limitations

of claim 1. Therefore, for any of the reasons set forth above with respect to claim 1, the Board of Appeals is respectfully requested to reverse the rejection of claims 2 and 5.

Claims 3-4, 7-11, 13-17 and 19-20 Are Not Obvious

Claims 3-4, 7-11, 13-17 and 19-20 stand rejected under 35 U.S.C. §103(a) as being obvious over Saito and Aw in further view of Waters. (Office Action at page 3). These claims are allowable for at least the same reasons discussed above.

Discussion regarding Claims 3 and 4

The Examiner has alleged that Waters discloses the elements added by claims 3 and 4. (Office Action at pages 3 and 4). Claims 3 and 4 depend directly, or by way of an intermediate claim, from claim 1 include all of the limitations of claim 1. Accordingly, even if Waters is proper prior art, which is not admitted, and discloses these elements, the combination of Saito and Aw is still improper for the reasons set forth above with respect to claim 1. Therefore, because the Examiner has admitted that Saito fails to disclose each limitation of claim 1, and because there is no motivation to combine Aw with Saito, claims 3 and 4 are patentable over the prior art and the Board of Appeals is respectfully requested to reverse the rejection of claims 3 and 4.

Discussion regarding Claim 7

Claim 7 is an independent claim that has been rejected on the same combination discussed above with respect to claims 3 and 4. (Office Action at page 4). Claim 7 includes, for purposes of this appeal, the same limitation that the Examiner has admitted

was not disclosed by Saito. (Office Action at page 3). Therefore, because there is no motivation to combine Aw with Saito, claim 7 is patentable over the prior art and the Board of Appeals is respectfully requested to reverse the rejection of claim 7.

Discussion regarding Claims 8-11

Claims 8-11 have been rejected based upon the same combination relied upon in the rejection of claim 7. (Office Action at page 5). Claims 8-11 depend directly, or by way of an intermediate claim, from claim 7 and include all of the limitations of claim 7. Therefore, because claim 7 is patentable, claims 8-11 are patentable over the prior art and the Board of Appeals is respectfully requested to reverse the rejection of claims 8-11.

Discussion regarding Claim 13

Claim 13 is an independent claim that has been rejected based upon the same combination and motivation discussed above with respect to claims 3 and 4. (Office Action at page 5). Claim 13 includes, for purposes of this appeal, the same limitation that the Examiner has admitted was not disclosed by Saito. (Office Action at page 3). Therefore, because there is no motivation to combine Aw with Saito, claim 13 is patentable over the prior art and the Board of Appeals is respectfully requested to reverse the rejection of claim 13.

Discussion regarding Claims 14-17

Claims 14-17 have been rejected based upon the same combination relied upon in the rejection of claim 13. (Office Action at pages 6-7). Claims 14-17 depend directly, or

by way of an intermediate claim, from claim 13 include all of the limitations of claim 13. Therefore, because claim 13 is patentable, claims 14-17 are patentable over the prior art and the Board of Appeals is respectfully requested to reverse the rejection of claims 14-17.

Discussion regarding Claim 19

Claim 19 is an independent claim that has been rejected on the same combination discussed above with respect to claims 3 and 4. (Office Action at page 7). Claim 19 includes, for purposes of this appeal, the same limitation that the Examiner has admitted was not disclosed by Saito. (Office Action at page 3). Therefore, because there is no motivation to combine Aw with Saito, claim 19 is patentable over the prior art and the Board of Appeals is respectfully requested to reverse the rejection of claim 19.

Discussion regarding Claim 20

Claim 20 has been rejected based upon the same combination relied upon in the rejection of claim 19. (Office Action at page 8). Claim 20 depends directly from claim 19 and includes all of the limitations of claim 19. Therefore, because claim 19 is patentable, claim 20 is patentable over the prior art and the Board of Appeals is respectfully requested to reverse the rejection of claim 20.

Claims 6, 12 and 18 Are Not Obvious

Claims 6, 12 and 18 stand rejected under 35 U.S.C. §103(a) as being obvious over Saito and Aw in further view of Treyz. (Office Action at page 8). Treyz is relied upon

solely for disclosing the elements added by claims 6, 12 and 18. (Office Action at page 8). Claims 6, 12 and 18 depend directly or by way of an intermediate claim from claims 1, 7 and 13, respectively, and include all of the limitations of the claims from which they depend. Therefore, because the Examiner has admitted that Saito fails to disclose each limitation of claims 1, 7 and 13 as discussed above, and because there is no motivation to combine Aw with Saito, the modification of Saito to include the interactive component of Treyz does not arrive at the invention of claims 6, 12 and 18. Accordingly, claims 6, 12 and 18 are patentable over the prior art and the Board of Appeals is respectfully requested to reverse the rejection of claims 6, 12 and 18.

Claims 21-22 Are Not Obvious

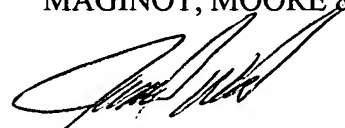
Claims 21 and 22 stand rejected under 35 U.S.C. §103(a) as being obvious over Saito, Aw, and Waters in further view of Dockery. (Office Action at page 8).). Dockery is relied upon solely for disclosing the elements added by claims 21 and 22. (Office Action at page 8). Claims 21 and 22 depend directly, or by way of an intermediate claim, from claim 19 include all of the limitations of claim 19. Accordingly, even if Dockery discloses these elements, the combination of Saito and Aw is still improper for the reasons set forth above with respect to claim 1. Therefore, because the Examiner has admitted that Saito fails to disclose each limitation of claim 19 as discussed above, and because there is no motivation to combine Aw with Saito, claims 21 and 22 are patentable over the prior art and the Board of Appeals is respectfully requested to reverse the rejection of claims 21 and 22.

(8) CONCLUSION

Claims 1-5 and 14-17 are not anticipated by Peterson or Cameron. Neither are they obvious in view of a combination of Peterson and Cameron or in view of Cameron alone. Accordingly, the Board of Appeals is respectfully requested to reverse the rejections of claims 1-5 and 14-17.

Respectfully submitted,

MAGINOT, MOORE & BECK

A handwritten signature in black ink, appearing to read 'James D. Wood', is written over the printed name.

James D. Wood
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November 28, 2005

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(9) CLAIMS APPENDIX

Claim 1. A method of providing an advertisement for a store to a prospective customer comprising the steps of:

compiling an advertisement;

formatting the advertisement into a radio signal having a radio transmission protocol that is receivable by a personal device of a prospective customer, the personal device having a radio receiver enabled to receive the transmission protocol signal; and

transmitting the radio signal from the store with a signal strength sufficient to be received by a personal device that is removed from the source of the transmission.

Claim 2. The method of claim 1, wherein the step of transmitting the radio signal from the store includes transmitting the radio signal from the store to within a perimeter of the store.

Claim 3. The method of claim 2, wherein the step of transmitting the radio signal from the store includes transmitting the radio signal from the store to within a perimeter that is outside of the store.

Claim 4. The method of claim 1, wherein the step of transmitting the radio signal from the store includes transmitting the radio signal from the store to within a perimeter that is outside of the store.

Claim 5. The method of claim 1, wherein the step of formatting utilizes Bluetooth™ radio transmission protocol, and the radio receiver of the personal device is Bluetooth™ enabled.

Claim 6. The method of claim 5, wherein the step of formatting includes the step of providing an interactive component to the radio signal.

Claim 7. An apparatus for providing an advertisement to a prospective customer comprising:

- a storage device operative to store an advertisement;

- a transmitter in communication with the storage device and operative to receive the advertisement from the storage device, the transmitter further operative to format the advertisement into a radio signal having a radio transmission protocol that is receivable by a personal device of a prospective customer having a radio receiver enabled to receive the transmission protocol signal; and

- an antenna in communication with the transmitter and operative to transmit the radio signal from the store.

Claim 8. The apparatus of claim 7, wherein the transmitter and antenna are operative to transmit the radio signal from the store to within a perimeter of the store.

Claim 9. The apparatus of claim 8, wherein the transmitter and antenna are further operative to transmit the radio signal to a limited distance outside of the store.

Claim 10. The apparatus of claim 7, wherein the transmitter and antenna are operative to transmit the radio signal to an area outside of the store.

Claim 11. The apparatus of claim 8, wherein the transmitter is operative to format the advertisement into a radio signal having Bluetooth™ radio transmission protocol.

Claim 12. The apparatus of claim 11, wherein the transmitter is operative to provide an interactive component to the radio signal.

Claim 13. A system for store advertising comprising:

- a storage device operative to store a store advertisement;

- a transmitter located at the store and in communication with the storage device and operative to receive the advertisement from the storage device, the transmitter further operative to format the advertisement into a radio signal having a radio transmission protocol that is receivable by a personal device of a prospective customer having a radio receiver enabled to receive the transmission protocol signal;

- a receiver located at the store and operative to receive an incoming radio signal of the radio transmission protocol from the personal device of the prospective customer; and

- an antenna located at the store and in communication with the transmitter and the receiver, the antenna operative to transmit the radio signal from the store and receive the incoming radio signal from the personal device.

Claim 14. The system of claim 13, wherein the transmitter and antenna are operative to transmit the radio signal from the store to within a perimeter of the store.

Claim 15. The system of claim 14, wherein the transmitter and antenna are operative to transmit the radio signal to a limited distance outside of the store.

Claim 16. The system of claim 14, wherein the transmitter and antenna are operative to transmit the radio signal to a distance inside of the store.

Claim 17. The system of claim 13, wherein the transmitter is operative to format the advertisement into a radio signal having Bluetooth™ radio transmission protocol.

Claim 18. The system of claim 13, wherein the transmitter is operative to provide an interactive component to the radio signal.

Claim 19. A system for store advertising comprising:

a storage device operative to store a store advertisement;

a transmitter in communication with the storage device and operative to receive the advertisement from the storage device, the transmitter further operative to format the advertisement into a radio signal having a radio transmission protocol that is receivable by a personal device of a prospective customer having a radio receiver enabled to receive the transmission protocol signal; and

an antenna located at or about a position proximate to the store and in communication with the transmitter and the receiver, the antenna operative to transmit the radio signal with a signal strength sufficient to be received by a personal device that is greater than 15 meters removed from the antenna.

Claim 20. The system of claim 19, wherein the transmitter and antenna are operative to transmit the radio signal to a perimeter that is greater than about 50 meters from the antenna.

Claim 21. The system of claim 19, wherein the transmitter and antenna are further operative to transmit the radio signal to a perimeter that is about 100 meters from the antenna.

Claim 22. The system of claim 21, wherein the perimeter comprises an area within the store and an area outside of the store.